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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/136,483	08/19/1998	SUJEET KUMAR	2950.25US01	1810

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/136,483

Applicant(s)

KUMAR ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/7/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 17-18 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claims 1-3, 5-10 and 19-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rostoker et al (U.S. Patent 5,389,194).

The Rostoker et al. reference teaches a method of polishing a surface using a polishing composition composed of particles dispersed in an aqueous solution. The taught particles are composed of alumina (alpha or gamma alumina-see column 4, lines 16-19) or silica particles. The particles have a size (X value of 10-100) and a distribution that is controlled to within a certain selected size (Y value which is "P" (10-50%) of "X"). See the claims. Example 3 teaches that the particles have an average particle size of 10 nm (the X value) and a distribution where all the particles have a size within 10% of the average particles size (the X value). This means that all the particles are within the range of 10% of the average particle size and 110% of the average particles size. Accordingly, there are no particles have a size greater than 3 times the average particle size. This is because 10% (P value) of 10 nm is 1 nm and 110% of 10 nm is 11 nm, thus the size distribution can be 10 nm  $\pm$  1 nm or a distribution of between 9-11 nm (reads on the distribution of instant claims 1, 23, 24 and 28). Similarly, assuming X to be 10 nm and P to be 50% (values clearly disclosed by reference), then Y would be 50% of 10 nm or 5 nm, thus the distribution can be 10 nm  $\pm$  5 nm, thus there are no particles have a size greater than 3 times the average particle size. With respect to the primary particle limitation, it is the examiners position that absent evidence to the contrary, the particle defined in the reference reads on a primary particle.

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The reference teaches a polishing composition which comprises the claimed collection of particles (see specific reasoning above), thus since the claimed invention suggests the claimed distribution for the reasons defined above, the instant claims are anticipated by the reference. Assuming *arguendo*, in the alternative, the reference clearly teaches a distribution which encompasses the claimed distribution because the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976).

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being obvious over Rostoker et al (U.S. Patent 5,389,194) in view of Farkas et al. (730).

Farkas et al. teaches in abstract and column 6, lines 14-20 that in polishing compositions the solvent can be water, an alcohol or a mixture thereof and that the abrasive is generally 1-12 percent of the slurry.

The primary reference is silent with respect to the amount of particles (claims 11-12) in the dispersion, however, it is the examiners position that that one skilled in the art would have routinely known the amount of abrasive to be included in the polishing slurry to produce the most optimum slurry, said amount being a conventional amount, as clearly shown by Farkas et al.

With respect to claims 13-14, Farkas et al. teaches that the use of an alcohol or alcohol/water medium is conventional in polishing compositions and is the examiners position

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that one skilled in the art would have routinely known that either water, alcohol or an alcohol/water carrier can be used as the dispersing medium to form polishing compositions.

With respect to claims 15-16, it is prima facie obvious to combine two or more materials disclosed by the prior art to form a third material (combination of abrasives) that is to be used for the same purpose. In re Kerkhoven 205 USPQ 1069.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-8 and 19-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all the claims of copending Application No. 09/969,025. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the copending claims would render obvious the instant claims.

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The copending claims suggest a collection of particles, wherein said particles can have a size distribution within the claimed range, thus meeting the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed 6/7/06 have been fully considered but they are not persuasive.

On pages 8-10 of the remarks, applicants argue case law relevant to the instant invention. The examiner acknowledges these citations, however, the examiner clearly established reasons why the instant invention is unpatentable over the prior art (see all of the previous prosecution histories presented by the office, all of said histories being incorporated herein by reference.) On page 10, it appears that applicants are arguing inoperability of the cited patent (Rostoker). Applicants argument of inoperability is not based on facts. A reference is presumed to be operable and the burden is upon applicants to show otherwise. Applicants have not defined any clear evidence of inoperability. The reference clearly teaches (as outlined above) a collection of particles having a nm size, wherein **no** particles have a size greater than 3 times the average particle size. Applicants also state that the Examiner, the Board and the Solicitor all had separate interpretations of the reference. This is not true because the interpretations are consistent even calculations made by the board where not made by the examiner in the initial office actions (prior to examiners answer). However, said calculation was made by the examiner in response to the remand from the board, thus the interpretations are consistent with one another. The Examiner cannot find any evidence to support this assertion. If applicants

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maintain this argument, they need to provide evidence of this argued inconsistency.

Applicants also make a statement that the examiner did not bother to re address any of these issues. What issues have not been re addressed? The examiner clearly incorporated the remarks in the previous office actions by reference. This clearly addresses all of the issues, contrary to applicants position.

Applicants' make a statement pertaining to the declaration of Dr. Singh in the paragraph bridging pages 11-12 of the Response in that the standard for evaluating the teachings of Rostoker is not what is possible but what a person of ordinary skill in the art would interpret the subject matter to mean. They further state that Dr. Singh is expert in the field. The examiner is not denying this (Dr. Singh is expert in the field), as applicant appear to argue. The Examiner has simply rebutted his arguments. Applicants have not presented any evidence showing the Examiner is incorrect in his rebuttal.

Applicants also argue that Rostoker et al. produces the particles by the Siegel et al. patent (5,128,081) method and this method is not capable of producing the claimed particle collection (i.e. size), see paragraph bridging pages 12-13 and last paragraph on page 13. The examiner disagrees because Rostoker et al. does not state that this is the only method of making the particles, but rather uses the Siegel et al. reference as showing a known **possible** method. Rostoker et al. does limit the method to the Siegel et al. method, as argued by the applicants. Applicants would also appear to argue that the particles taught in the Rostoker et al. patent are those of the Siegel et al. patent. Applicants are apparently ignoring the teachings in Rostoker that define that the particles have the claimed distribution. Applicants state that the declaration of Dr Kambe establishes that that no method was available for making the claimed particle

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collection (size). The declaration is insufficient to overcome the rejection because it amounts to an affirmation that the affiant has never seen the claimed subject matter before. This is not relevant to the issue of anticipation or nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP 716. Accordingly, it does not overcome the rejection. The fact that the examples (of Rostoker) do not say how to obtain the particles within the taught ranges does not overcome the rejection. A reference does not require specific disclosure of what is already known to one of ordinary skill in the art. *Case v. CPC International Inc.* 221 USPQ 196, 201 (Fed. Cir. 1984). There has been no showing that method of producing or forming the disclosed particle size distribution were not already known to one of ordinary skill in the art. Applicants have not presented any evidence that no other methods were known to produce the taught particles. To rebut this argument, reference is made to U.S. patent 4,842,837 which teaches a method for forming silica articles of 100 nm or less. Although this patent is directed to the manufacture of silica particles, it is the examiners position that the skilled artisan would have appreciated that it is applicable to alumina particles, as well, especially since Rostoker teaches that the particles can be silica or alumina. Notwithstanding the above patent, Rostoker teaches the claimed particles size and since the claimed particle size is clearly taught, it must have been made by a method consistent with producing said size.

Applicants also argue in first full paragraph on page 13 that the prior art does not enable a person skilled in the art to make or use the invention. This is not persuasive because the art clearly shows that the claimed particles are known and since the claimed particle size is clearly taught, it must have been made by a method consistent with producing said size. The inventors of the Rostoker patent are also clearly skilled artisan and thus since the claimed particle size is



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known, the inventors of said patent must have known how to produce the size disclosed therein. The fact that the examples (of Rostoker) do not say how to obtain the particles within the taught ranges does not establish that methods for making the particles is unknown because they must have been made. As defined above, a reference does not require specific disclosure of what is already known to one of ordinary skill in the art. *Case v. CPC International Inc.* 221 USPQ 196, 201 (Fed. Cir. 1984). In view of this, the reference clearly enables the invention disclosed therein. Finally, applicants argue that the examiner has not reviewed Dr Kambe's declaration in view of professor Singh's declaration. The examiner has done this, however, the reevaluation does not remedy the examiners position above. These declarations do not establish clear evidence of unobviousness over the reference applied.

It would appear that applicants are primarily focusing on the production method, however, the claims are not defined in terms of a method. In view of this, any arguments pertaining to the method are irrelevant and the claims are interpreted in view of the size requirements. The Rostoker et al. clearly teaches particles composed of alumina (alpha or gamma alumina-see column 4, lines 16-19) having a size (X value of 10-100) and a distribution that is controlled to within a certain selected size (Y value which is "P" (10-50%) of "X"). See the claims. Example 3 teach that the particles have an average particle size of 10 nm (the X value) and a distribution where all the particles have a size within 10% of the average particles size (the X value). This means that all the particles are within the range of 10% of the average particle size and 110% of the average particles size. Accordingly, there are no particles have a size greater than 3 times the average particle size. This teaching clearly reads on the claimed size because all of the size requirements are clearly disclosed by this reference. If applicants contest this, they must show

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clear reasons as to why the size disclosed by the reference is not the claimed size. To date, applicants have not clearly established any differences.

With respect to the ODP (obvious double patenting rejection) based on 09/969,025, applicants argue that an ODP rejection is not proper for applications filed after June 8, 1995. This is not persuasive because the MPEP section applicants refer to clearly states that a ODP can be made in application filed after June 8, 1995

The other ODP rejections are withdrawn in view of (1) applicant amendments to the claims of the copending applications, (2) applicants arguments or (3) the terminal disclaimer submitted.

Claims 17 and 18 are allowed.

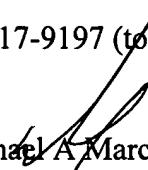
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/24/06  
MM

  
Michael A. Marcheschi  
Primary Examiner  
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